

In re Patent Application of:
WALLACE ET AL.
Serial No. 10/764,770
Filed: **JANUARY 26, 2004**

REMARKS

Claims 1-9 were in the application at the time of the Examiner's examination. Claims 1-9 were rejected by the Examiner.

In the "Examiner's Note" on page 2 of the Office Action, the Examiner states:

The Examiner notes the applicant's inclusion of, "For use with an electronic signal processing apparatus containing a security key memory which stores a security key that enables a user to operate said electronic signal processing apparatus," in Claims 1 & 5. It is noted that this recitation does not provide further limitation to these claims and appears to be an intended use.

35 U.S.C. § 112, second paragraph states:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. [emphasis added]

The "Examiner's Note" appears to be an attempt to eliminate from the claim language, language which the Applicants consider to be part of the claimed invention. Further, although the language to which the Examiner objects is found in preamble, it is in fact referred to in the body of the claims. Case law interpreting when a preamble is required to be considered requires (in summary) that the preamble should be included when it gives life and vitality to the claims. The explicit references in the body of the claim language beyond the preamble to the preambular language meets that requirements and should be considered as part of the

claim. Thus, the Examiner is required to consider the claim language as a whole when asserting a rejection.

On page 2 of the specification, the Examiner objected to a misspelling at page 2, line 7 of the specification. Applicants have adopted the Examiner's suggested change.

On page 3 of the Office Action, the Examiner rejected claims 5-8 under 35 U.S.C. § 112, second paragraph, as indefinite. The Examiner states that the term "operative" is a "relative term" which renders the claim indefinite. Further, the Examiner states that the usage of the term "operative" is "similar to" that of capable or operable and does not define the scope of the invention clearly.

In context, claim 5 reads:

...a control circuit, which is operative, in response to said change in the bit state of said single-bit storage device, to change the contents of said security key memory so as to effectively remove said security key from said security key memory [emphasis added]

There is nothing relative in the use of the term "operative" in claim 5. The term "operative" in claim 5 describes what the claim limitation does. Accordingly, Applicants respectfully request that the Examiner reconsider the objection to the term "operative" in claims 5-8.

On page 3 of the Office Action, beginning paragraph 5, the Examiner states:

The Examiner notes the usage of the term "arrangement" in claims 5 and 6. It is noted that the two claims 5 & 6 appear to be a system and an apparatus respectively. However, the

usage of the term "arrangement" in both claims makes them indefinite. One of ordinary skill in the art may not be able to discern which claims are a system or an apparatus, since it appears that an "arrangement" may be either one or both.

The Examiner appears to undertake an interpretation of claims 5 and 6 at odds with the actual language of those claims. It is not clear upon what the Examiner bases the conclusion that claims 5 and 6 appear "to be a system and an apparatus respectively." The claim language states what it states.

Even more extraordinary is the Examiner's assertion that "the usage of the term 'arrangement' in both claims makes them indefinite." The Examiner appears to be asserting that the use of the same word in a system claim and an apparatus claim results in some type of indefiniteness. The term "arrangement" should be interpreted in the context of its usage in each individual claim. There is no support for a rejection of indefiniteness based on usages in different claims.

Accordingly, the Examiner is requested to reconsider and withdraw the rejection based on the use of the term "arrangement" in claims 5 and 6.

The Examiner rejected claims 1-9 under 35 U.S.C. § 102 as anticipated by Sutherland. Although Sutherland makes no reference to a security key or a security key memory, it is clear that Sutherland makes no teaching whatsoever of "a single-bit storage device" which is now found in each of the independent claims. Further, Sutherland does not teach or suggest the use of the single-bit storage device in the manner claimed.

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In the discussion of the various claims, the Examiner purports to map language from the reference to a "single-bit storage device." However, each of the mappings has nothing to do with a single-bit storage device nor with the use of a single-bit storage device as claimed. The purported mapping given in the Examiner's explanation of the rejection is contrary to the teachings of Sutherland which has no reference to a single-bit storage device.

Accordingly, the Examiner is requested to reconsider the rejection and to allow the application as amended.

Should any minor informalities need to be addressed, the Examiner is encouraged to contact the undersigned attorney at the telephone number listed below.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 01-0484 and please credit any excess fees to such deposit account.

Respectfully submitted,



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